REMARKS

Reconsideration of the instant application is respectfully requested. The present submission is responsive to the Office Action of April 19, 2005, in which claims 1-20 are presently pending. Of those, claim 20 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

With regard to the art of record, claims 1 and 13 have been rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Patent 6,205,266 to Palen, et al. In addition, claims 2-8, 11, 12 and 14-19 have been rejected under 35 U.S.C. §103(a), as being unpatentable over Palen, et al. Finally, claims 9, 10 and 20 have been rejected under 35 U.S.C. §103(a), as being unpatentable over Palen, et al., and further in view of U.S. Patent 6,690,864 to Dee, et al. For the following reasons, however, it is respectfully submitted that the application is in condition for allowance.

Independent claims 1 and 13 have been amended as indicated above to incorporate the actuator mechanism elements of cancelled claims 8/9 and 20, respectively, therein. Moreover, claims 1 and 13 have further amended to more particularly point out that the specific actuator means is a real-time mechanism (i.e., one that provides real-time compensation for positional drifts due to various operating phenomena). Support for this amendment is found at least at page 4, lines 9-20 of the specification. In addition, as a result of the amendment to claims 1 and 13, claims 2, 14 and 19 have been amended for antecedent basis reasons. Claims 3, 8, 9 and 20 have been cancelled.

The present amendment overcomes each of the outstanding claim rejections. First, the §112, second paragraph rejection of claim 20 has been rendered moot by the cancellation thereof. It is noted that independent claim 13 now provides antecedent basis

for the term "housing." With regard to the art of record, the §102 and §103 rejections of the claims based solely on the Palen reference have been overcome, as each of the remaining claims now includes specific recitations concerning the actuator mechanisms. As stated by the Examiner on page 7 of the Office Action, "Palen et al. are silent regarding further details of the actuator mechanisms in their system..." Further, the Applicants point out that not only are there no details provided on the actuator mechanisms (e.g., 86, 88, 90), they are schematically depicted as not having any coupling relationship with respect to one another, as is presently claimed.

With regard to the §103 rejections of the claims based on the combination of the Palen and Dee references, the Applicants respectfully traverse the same for the reason that one skilled in the art would not be motivated to combine the specific actuator mechanisms of Dee with a real-time alignment system as shown in Palen.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that (1) all elements of the claimed invention are disclosed in the prior art; (2) that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references; and (3) that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

With regard to the second element, there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation

to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

A review of the Dee reference reveals that the alignment system disclosed therein is of the type characterized by the Applicants in the background section of the present application as an "align and affix" system. In other words, the Dee apparatus is used to provide an initial alignment of optical components, followed by a permanent affixation once the initial alignment is achieved. The alignment and insertion apparatus 18 of Dee is not a permanent part of the OE device itself, and thus does not provide "real-time" alignment as presently claimed. For example, column 3, lines 25-61 of Dee describe the mounting of a package body 60 to the alignment apparatus 18, with an optical fiber 52 inserted into an axial bore of a ferrule 62 of the package body. Following the insertion and alignment, the fiber is bonded to the bench in the package 60. Therefore, once the initial alignment is accomplished, the optical component is permanently affixed and no real-time alignment of the OE component is thereafter possible during the actual operation thereof as a result of such phenomena as CTE mismatch.

Thus, although the Palen and Dee references are generally directed toward optical alignment, the former is in the context of real-time alignment while the latter is in the context of initial alignment followed by affixing the OE component(s). Therefore, one skilled in the art would not look to the actuator mechanisms of an "align and affix" system as in Dee to provide the real-time alignment adjustments for the system of Palen. This also becomes apparent when comparing the sheer size of the platform/rail alignment system of Dee to the optical bench 60 in which a fiber is aligned.

Accordingly, for the above stated reasons, it is respectfully submitted that each of the outstanding rejections have been overcome and that the present application is now in condition for allowance. No new matter has been entered and no additional fees are believed to be required. However, if any fees are due with respect to this Amendment, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,
ERIC V. KLINE, ET AL.

CANTOR COLBURN LLP
Applicants' Attorneys

By _____
Sean F. Sullivan
Registration No. 38,328
Customer No. 29371

Date: July 19, 2005
Address: 55 Griffin Road South, Bloomfield, CT 06002
Telephone: (860) 286-2929